

Appl. No. 10/083,737  
Amtd. Dated Jan. 27, 2004  
Reply to Office action of Sept. 17, 2003

REMARKS

In the Official Action, the Examiner made a restriction requirement in this application, between the following groups:

I -- Claims 1-17 and 23-51, drawn to a method of modifying a polymeric surface; and

II --Claims 18-22, drawn to a polymeric composite and medical device.

Applicant provisionally elects with traverse the claims of Group I (Claims 1-17 and 23-51). Claims 18-22 have now been cancelled without prejudice and may be subject of the filing of a divisional application.

The Examiner is kindly thanked for the allowance of claims 8-17, 24-35 and 39 if rewritten to overcome the rejection(s) under 35 U.S.C. 112 and if rewritten to include all the limitations of the base claim and any intervening claims. Claims 1, 9-17 and 23-53 are now before the Examiner. Claims 1, 4, 7-10, 12, 15-17, 23, 25, 28-31, 36, 39, 42, 43 and 45 have been amended, claims 2-8 and 11 have been cancelled without prejudice and claims 18-22 have been withdrawn without prejudice.

Specifically, claim 1 has been amended as suggested by the Examiner to incorporate the limitations of claim 8 and claims dependent therefrom. Consequently, claims 2-8 have been cancelled. Claim 12 has been amended to be properly dependent. Claim 17 has been amended to be independent and to include the limitations of original claim 1. Claims 4, 7-10, 12, 15, 16, 23, 25, 28-31, 36, 39, 42, 43 and 45 have been amended as outlined below. Claims 18-22 have been withdrawn without prejudice. Claims 8, 29 and 43 have been amended to correct a typographical error. New claims 52 and 53 have been added that are directed to a method whereby a polymeric material is rendered lubricious and further a silver agent is provided to the modified polymeric surface.

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### 35 U.S.C. 112

The Examiner has rejected claims 1-17, 23-35 and 39 as indefinite, on the grounds that these claims fail to particularly point out and distinctly claim the invention.

With respect to claims 1 and 23, the Examiner asserts that the phrase "aqueous monomer" lacks clarity. Claims 1 and 23 have been amended to recite "aqueous monomer solution". The abbreviation "UV" has also been replaced with "ultraviolet (UV)" in claims 1, 23 and 36.

With respect to claims 4, 25 and 39, the Examiner has objected to the wording of these claims, on the grounds that the term "silicone" lacks a proper antecedent. Claims 4, 25 and 39 have been amended to depend from claim 1, 23 and 36, respectively, in order to provide a proper antecedent basis.

With respect to claims 7, 28 and 42, the Examiner has noted that the symbol "α" is missing from the term "-hydroxyketones". The claims have been amended to properly recite the term "α-hydroxyketones".

With respect to claims 9 and 30, the Examiner has objected to these claims, in that it is unclear as to whether the monomer contains photoinitiating groups or the aqueous solution comprises a monomer and a photoinitiator. These claims have been amended to clarify that it is the latter.

With respect to claim 10, the Examiner asserts that it is unclear how the method of claim 8 differs from the method of claim 10. Claims 10, 31, and 45 have been amended to clarify claim language to distinguish them from claims 8, 29, and 43, respectively.

With respect to claims 15 and 16, the Examiner has objected to the wording of these claims, on the grounds that the recitation "prior to incubation in a silver salt" lacks a proper antecedent basis. Claims 15 and 16 have been amended to provide a proper antecedent basis.

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With respect to claim 17, the Examiner has objected to the wording of this claim, on the grounds that it is unclear how the polymeric material with the modified surface came to be coated with a gelatin polyethylene oxide hydrogel having a silver salt incorporated therein. Claim 17 has been amended to clarify language.

With respect to claim 23, the Examiner has also objected to the wording of this claim, on the grounds that the phrase "said ionized modified polymeric surface" lacks a proper antecedent. Claim 23 has been amended to recite "said lubricious modified polymeric surface".

### 35 U.S.C. 102

The Examiner has rejected claims 1 to 3 under 35 U.S.C. 102(b) as being anticipated by Ottersbach et al. (U.S. Patent No. 6,001,894). The Examiner has also rejected claims 1 to 5 under 35 U.S.C. 102(b) as being anticipated by Chabrecek et al. (U.S. Patent No. 6,447,920). The Examiner has also rejected claims 1-4, 1-7, 1-3, and 1-5 under 35 U.S.C. 102(b) as being anticipated by Inoue et al. (J. Appl. Polym. Sci., Vol. 29, 877-889 (1984)); Ikada et al. (Surface Grafting, pages 125-126); Ulbricht et al. (J. Membr. Sci. 120, 239-259 (1996)); and Sawhney et al. (U.S. Patent No. 5,844,016), respectively.

As the Examiner indicated claim 8 to be allowable if rewritten to contain all of the limitations of the base claim and any intervening claims, the subject matter of claim 8 and any intervening claims has been incorporated into claim 1. This obviates the rejections raised by the Examiner.

Furthermore it is asserted that the cited references do not teach or suggest, either singly or in combination, rendering the modified surface of the polymeric material lubricious.

Ottersbach et al. is directed to a process wherein a polymer substrate is initially pretreated with both a photo-initiator and at least one monomer (see Column 6, lines

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46-48). This is "a significant feature of the invention" (see Column 6, line 46). The monomer is used to initiate swelling of the polymer substrate, which allows the photoinitiator to penetrate into the regions of the polymer substrate (see Column 6, lines 55-58). The monomer and initiator are applied to the polymer substrate by conventional coating methods (see Column 7, lines 56-59). In contrast, the polymer substrate (e.g. polymeric material) of the claimed invention is already coated with the photoinitiator prior to incubation with a monomer solution.

Chabrecek et al. is directed to an organic bulk material having covalently bonded to its' surface, initiator moieties, such as photoinitiators, for radical polymerization. Macromonomers are applied to the bulk material and polymerized. In contrast, the modified surface of the inert polymeric material photoinitiator-coated inert polymeric material is grafted with a monomer solution not a macromer solution.

As such, new claims 52 and 53 are patentable in view of the cited references.

### 35 U.S.C. 103

The Examiner has rejected claims 1-7 under 35 U.S.C. 103(a) as being unpatentable over Wang et al. (U.S. Patent No. 6,358,557). This rejection is moot in view of the amendments made to claim 1 discussed *supra*.

The Applicants respectfully request a timely Notice of Allowance for this case.

Respectfully submitted,

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